

REMARKS

In the Official Action, the Examiner rejected claims 1-3, 5-7, and 10-15. Claims 4, 8, and 9 were previously withdrawn from consideration. Accordingly, Applicant respectfully requests reconsideration and allowance of the present application in view of the following remarks.

Rejections Under 35 U.S.C. § 103

Under 35 U.S.C. § 103(a), the Examiner rejected claims 1-3, 5, 6, 11-13, and 15 as unpatentable over Abileah et al., U.S. Patent No. 5,629,784 (hereinafter, "Abileah") in view of Silverstein et al., U.S. Patent No. 5,442,467 (hereinafter, "Silverstein"); the Examiner rejected claim 7 as unpatentable over Abileah in view of Silverstein in view of Varaprasad et al., U.S. Patent No. 6,087,012 (hereinafter, "Varaprasad"); the Examiner rejected claims 1-3, 5, 6, 11-14, and 15 as unpatentable over Abileah in view of Sanelle et al., U.S. Patent No. 6,181,394 (hereinafter, "Sanelle"); and the Examiner rejected claim 7 as unpatentable over Abileah in view of Sanelle in view of Varaprasad. Applicant respectfully traverses the foregoing rejections.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to

combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *see* M.P.E.P. § 2143.01. Similarly, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01.

Omitted Features

Independent claim 1 recites, *inter alia*, “a **bulk diffuser** disposed between the transmissive display screen and the backside, wherein the bulk diffuser is bonded to at least one of the transmissive display screen and the transparent panel, and the bulk diffuser is configured to diffuse image light originating from a backlight of the display.”

In the present Office Action, the Examiner relied on Abileah as the primary reference for each of the rejections. In these rejections, the Examiner specifically stated:

Abileah discloses in Figure 1 (a), a display comprising: a transmissive LCD display screen, 3-15,; a transparent glass panel, 35, (col. 8, lines 10-15) having a backside and an anti-reflective (Applicant's anti-glare) front surface (col. 14, lines 15-32) configured to diffuse ambient light, which results in reduced glare (multiple examples taught); and a diffuser, 21 (Applicant's bulk diffuser), (col. 11, lines 54-62) disposed between the transmissive display screen and the backside, and the bulk diffuser is configured to diffuse image light originating from a backlight, 2, of the display.

Office Action, Paper 20040217, Page 2. The Examiner further acknowledged that Abileah does not disclose “bonding” of the diffuser and, thus, the Examiner relied on either Silverstein or Sanelle for this feature. In either case, the Examiner clearly relied on Abileah for its alleged teaching of a “bulk diffuser,” as recited in claim 1. The Applicant respectfully traverses these rejections.

Abileah does not teach or suggest a bulk diffuser. As discussed in the specification of the present application, “a ‘bulk’ diffuser . . . utilizes a diffuser material to provide internal scattering rather than the surface scattering provided by etching.” Application, Page 13, lines 6-8. In sharp contrast, Abileah discloses a diffuser 21 having a *roughened or light scattering surface* 33. See Abileah, Figs. 1(a), 2, and 3; Col. 11, lines 54-62; Col. 13, lines 16-19; Col. 15, lines 6-9; Col. 24, lines 6-14 and 58-60. In other words, the diffuser 21 of Abileah scatters light externally rather than internally. Thus, one of ordinary skill in the art would readily recognize that the

diffuser 21 of Abileah is not a “bulk diffuser,” as recited in the instant claims. Moreover, the remaining references do not obviate this deficiency of Abileah.

For this reason, the cited references, taken alone or in combination, cannot teach or suggest the instant claims. Accordingly, the Applicant respectfully requests that the Examiner withdraw all outstanding rejections under 35 U.S.C. § 103.

Improper Combination: Cited References Teach Away from One Another

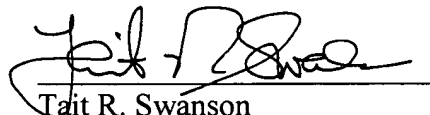
In addition to the foregoing deficiency, the Applicant stresses that Abileah teaches away from “bonding” the diffuser 21 to adjacent layers. Specifically, Abileah discloses: “Because of the roughness of the microstructure defining surface 33, *air gaps* are defined between surface 33 and the interior surface of polarizer 15, these gaps preferably not being filled with index matching oil or adhesive.” Abileah, Col. 15, lines 10-13 (emphasis added). In view of the legal precedent set forth above, the Applicant stresses that this passage is a strong teaching away from the use of a bonding material with the diffuser 21. For this reason, the Examiner’s proposed combinations of Abileah-Silverstein and, alternatively, Abileah-Sanelle are improper and cannot stand. Therefore, the Applicant respectfully requests that the Examiner remove these combinations and withdraw all outstanding rejections under 35 U.S.C. § 103.

Conclusion

As discussed above, Applicant respectfully submits that all pending claims should be in condition for allowance. Accordingly, Applicant requests the Examiner withdraw the outstanding rejections. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Date: May 28, 2004

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Tait R. Swanson', written over a horizontal line.

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